



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/342,971	06/29/1999	TONY F. RODRIGUEZ	4830-53055/W	7370

23735 7590 12/28/2001

DIGIMARC CORPORATION  
19801 SW 72ND AVENUE  
SUITE 100  
TUALATIN, OR 97062

EXAMINER

LASTRA, DANIEL

ART UNIT	PAPER NUMBER
----------	--------------

2162

DATE MAILED: 12/28/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

H. G

**Office Action Summary**

Application No.

09/342,971

Applicant(s)

RODRIGUEZ ET AL.

Examiner

DANIEL LASTRA

Art Unit

2162

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) Z.                      6) ☐ Other:

1. Claims 1-5 have been examined.

***Drawings***

2. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rathus et al (U.S. 5,932,863) in view of Rhoads (U.S. 6,285,776).

As per claim 1, Rathus et al teach:

“steganographically encoding a print advertisement to hide plural-bit data therein”  
(see column 5, lines 21-27 and column 6, lines 13-16);

“using at least a part of the extracted plural-bit data to direct an Internet web browser to a web site that provides consumer information related to a product or service promoted by the print advertisement” (see column 7, lines 61-67 – column 8, lines 1-23). Rathus et al do not explicitly mention an Internet web browser. However, the Rathus et al system teaches that the communication of certain information, such as pricing information or scheduling information, from the server to the user display unit, would easily be transmitted via an inexpensive telephone/modem link (see column 10,

Art Unit: 2162

lines 40-48). Also, Rathus et al teach that one of the services provided to the customer upon processing the print advertisement to extract the embedded data, is a computer "chat" link. The Internet, to one ordinary skilled in the art, for some time now is recognized as a vehicle in which information is shared from computer to computer. A typical example would be a chat room site where customers communicate or chat with each other. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the Rathus et al system could provide a computer "chat" link by a telephone/modem link and that it would use a web browser to connect to the Internet and provide consumer information related to a product or service. This feature would provide users with a way to obtain product information no matter where they are located.

Rathus et al fail to teach "acquiring visible light scan data from the print advertisement and processing same to extract the plural-bit data therefrom". However, Rhoads teaches a method of using a visible light scanner to recognize a security document by referencing to a steganographic digital watermark encoded in the document (see claim 3). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that steganographic data is digital data in hidden form and that the invisible bar code described in Rathus et al (see column 6, lines 10-16) would be read by the visible light scanner taught in Rhoads.

As per claim 2, Rathus et al teach:

"steganographically encoding a first print advertisement with first data" (see column 5, lines 22-27 and column 6, lines 10-35) ;

"steganographically encoding a second print advertisement with second data" (see column 5, lines 22-27 and column 6, lines 10-35);

Rathus et al does not expressly teach, "tallying the number of decoded first and second data, respectively, to determine consumer response to the advertisements". However, lines 31-35 of column 6 teach of an identification code generated by a recognition unit that allows the advertiser to identify the potential customer. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the advertiser would recognize the decoded data and that it would be used to better target advertisement to customers.

Rathus et al fail to teach, "decoding the first and second data when consumers present the first and second advertisements to visible light optical sensor". However, Rhoads teaches a method of using a visible light scanner to recognize a security document by referencing to a steganographic digital watermark encoded in the document (see claim 3). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that steganographic systems conveys digital data in hidden form and that the invisible bar code described in Rathus et al (see column 6, lines 10-16) would be read by the visible light scanner taught in Rhoads.

As per claim 4, Rathus et al teach:

"steganographically encoding a travel photograph to hide plural-bit data therein" (see column 5, lines 21-27, column 6, lines 13-16 and column 7, lines 61-67 – column 8, lines 1-23);

"using at least part of the extracted plural-bit data to direct an Internet web browser to a web site that provides travel information useful to a consumer who wishes to visit the location depicted in the photograph" (see column 7, lines 61-67 – column 8, lines 1-23). Rathus et al do not explicitly mention an Internet web browser. However, the Rathus et al system teaches that the communication of certain information, such as pricing information or scheduling information, from the server to the user display unit, would easily be transmitted via an inexpensive telephone/modem link (see column 10, lines 40-48). Also, Rathus et al teach that one of the services provided to the customer upon processing the print advertisement to extract the embedded data, is a computer "chat" link. The Internet, to one ordinary skilled in the art, for some time now is recognized as a vehicle in which information is shared from computer to computer. A typical example would be a chat room site where customers communicate or chat with each other. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the Rathus et al system would provide a computer "chat" link by a telephone/modem link and that would use a web browser to connect to the Internet and provide travel information useful to a consumer. This feature would provide users with a method to obtain product information no matter where they are located.

Rathus et al fail to teach, "acquiring visible light scan data from the travel photograph and processing same to extract the plural-bit data therefrom". However, Rhoads teaches a method of using a visible light scanner to recognize a security document by referencing to a steganographic digital watermark encoded in the document (see claim

Art Unit: 2162

3). Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that steganographic systems convey digital data in hidden form and the invisible bar code described in Rathus et al (see column 6, lines 10-16) would be read by the visible light scanner taught in Rhoads.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fajkowski (U.S. 5,905,246).

As per claim 3, Fajkowski teaches:

“presenting an object within the field of view of a visible light optical sensor device, the object being selected from the list consisting of a retail product, or packaging for a retail product” (see column 15, lines 11-41 and column 8, lines 37-40);

“acquiring optical data corresponding to the object” (see column 15, lines 20-28);

“decoding plural-bit digital data from the optical data” (see column 15, lines 20-28);

“submitting at least some of said decoded data to a remote computer” (see column 22, lines 10-67); and

Fajkowski does not expressly teach, “determining at the remote computer whether a prize should be awarded in response to submission of said decoded data”. However, as columns 22-24 teach, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that Fajkowski provides incentives to customers for buying at their store. Awarding prizes would be equivalent to awarding incentives and would not patentably distinguish the claimed invention from the prior art.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fajkowski (U.S. 5,905,246) in view of Rathus et al (U.S. 5,932,863).

As per claim 5, Rathus et al teach the method of claim 3 in which the optical data includes steganographically encoded information (see column 6, lines 10-16). The Applicant recognizes (in the specification on page 4) that steganographic data conveys data in hidden form. Therefore, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the invisible bar code described in Rathus et al on column 6, lines 10-16 would also convey steganographically encoded information.

### ***Conclusion***

4. The Applicant argues that Rathus et al do not use the term steganography, or the like and that the invisible bar code described in Rathus is not detailed or enabled.

The Examiner answers that in the specification at page 4, the Applicant recognizes that steganographically encoded data is defined as data in hidden form, (i.e. on human inspection it is not apparent that digitally encoded data is present). Since the invisible bar code described in Rathus et al (see column 6, lines 10-16) would meet the definition of steganographically data, Rathus et al indeed teach the term steganographic, even though it is not explicitly mentioned.

The Applicant further argues that Rathus does not teach any steganographic encoding of a travel photograph to hide plural-bit data. According to the Applicant, while Rathus uses the word "travel", he uses it in the context of a printed travel schedule rather than a photograph of a place that includes steganographic encoding that serves to link it to a travel web site.



The Examiner answers that in the Rathus system lines 60-67 of column 7 and lines 1-12 of column 8 teach that the customer view and interact with printed matter to cause a coded signal indicative of the customer's selection to be transmitted (either by a transmitter embedded in the printed matter or within a feature recognition unit) to controller. In response controller utilizes a modem to communicate to the Internet. In the Rathus system printed matter is defined as throwaway catalog or advertising brochure listing commercial items. However, it would have been obvious to a person of ordinary skill in the art at the time the application was made, to know that the advertising brochure would include traveling photograph with embedded code to link the customer to the travel website.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL LASTRA whose telephone number is 703-306-5933. The examiner can normally be reached on 6:30-3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ERIC W STAMBER can be reached on 703-305-8469. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7239 for regular communications and 703-746-7238 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

  
ERIC W. STAMBER  
PRIMARY EXAMINER